



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 03 2003
TECH CENTER 1600/2900

In re application of:

Joseph R. BYRUM *et al.*

Appl. No.: 09/669,817

Filed: September 26, 2000

For: **Nucleic Acid Molecules and Other
Molecules Associated with Plants**

Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

Atty. Docket: 38-21(51469)B

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**REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT –
NO ABANDONMENT IN FACT (or in the alternative, Petition to Revive
Unintentionally Abandoned Application)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with MPEP § 711.03, withdrawal of the holding of abandonment in the above-captioned application is respectfully requested, there being no abandonment in fact.

On October 9, 2002, Applicants' representative previously filed in the above-referenced case a Request for Withdrawal of Holding of Abandonment – No Abandonment in Fact (or in the alternative, Petition to Revive Unintentionally Abandoned Application), ("Request"). See Exhibit A. The October 9, 2002 Petition included a clear and unambiguous authorization to charge a Deposit Account, "\$1280.00, to cover the petition fee set forth in 37 C.F.R. § 1.17(m)," in the event that the Office failed to grant a withdrawal of the holding of abandonment and instead chose to treat it as a Petition to Revive Unintentionally Abandoned Application. See Exhibit A at page 3.

A copy of the transmittal letter dated October 9, 2002, and a copy of a date-stamped postcard indicating receipt of Applicants' Response on October 9, 2002 by the United States

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OFFICE OF PETITIONS

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Patent and Trademark Office/Office of Initial Patent Examination, are attached hereto as Exhibits B and C.

On April 4, 2003, Applicants' representative at Arnold and Porter made an oral inquiry to the Office of Initial Patent Examination Division (OIPE), which inquiry revealed that the above-identified application is still regarded as abandoned, allegedly because no petition fee was submitted with the October 9, 2002 Petition. Applicants respectfully assert that the required fee was submitted with said Petition, in the form of the aforementioned instructions to charge the deposit account should such a fee be found appropriate in light of the arguments presented by Applicants in said Petition. Applicants therefore respectfully request withdrawal of the holding of abandonment, and thus re-present below the substantive arguments of the October 9, 2002 Petition.

On January 8, 2001, a Notice to Comply was mailed to Applicants' representative at Monsanto Company. The due date for responding to the Notice to Comply was March 8, 2001. On February 15, 2001, Applicants' representative filed a responsive submission to the Notice to Comply ("Applicants' Response") which included a Response to the Notice to Comply, accompanied by a copy of the Notice, a copy of the original application Transmittal, a copy of a Petition to Suspend Sequence Rules originally filed on September 26, 2000, a substitute compact disc, and a Statement Regarding Sequence Submission, each accompanied by Certificates of Mailing certifying that the documents were deposited with the U.S. Postal Service as First Class Mail on February 15, 2001. A copy of Applicants' Response (except for the compact disc) is attached hereto as Exhibit D.

A copy of a date-stamped postcard indicating receipt of Applicants' Response on February 20, 2001 by the United States Patent and Trademark Office/Office of Initial Patent Examination is attached hereto as Exhibit E.

On October 9, 2001, a Corrected Decision on Petition was mailed to Applicants' representative at Monsanto Company. The Corrected Decision granted Applicants' earlier

petition to waive the requirements of the sequence rules as they existed at that time, and requested that Applicants submit additional copies of the sequence listing on compact disc. On December 7, 2001, Applicants' representative at Arnold & Porter filed a responsive submission to the Corrected Decision on Petition, a copy of which is attached hereto as Exhibit F. A copy of a date-stamped postcard indicating receipt of this responsive submission, including replacement copies of the sequence listing on compact disc, by the United States Patent and Trademark Office/Office of Initial Patent Examination is attached hereto as Exhibit G.

On September 9, 2002, a Notice of Abandonment (Exhibit H) was mailed to Applicants' representative at Monsanto Company, alleging that the above-identified application "is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on January 8, 2001." No such Notice was received. The Notice mailed January 8, 2001 that was received by Applicants' representative at Monsanto Company was not a Notice to File Missing Parts, but rather a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosure. Furthermore, the application met the statutory requirements of 35 U.S.C. § 111 when it was filed on September 26, 2000 because it contained a specification, the signed oaths of the inventors, and the required filing fees (*see* Transmittal in Exhibit D). Therefore, no Notice to File Missing Parts would have been expected to be mailed because nothing required by statute was missing from the application as filed. Accordingly, it is the belief of Applicants' representative that the Notice of Abandonment contains a typographical error with respect to the title of the Notice, and that no Notice to File Missing Parts was ever mailed by the United States Patent and Trademark Office.

With respect to the Notice to Comply mailed January 8, 2001, Applicants submitted a timely and proper reply, which was received by the United States Patent and Trademark Office on February 20, 2001 (*see* Exhibits D and E). Therefore, the above-identified application is not abandoned in fact.

Applicants' October 9, 2002 Request for Withdrawal of Holding of Abandonment was filed within two (2) months of the mailing of the Notice of Abandonment. Applicants' October

9, 2002 petition was not considered, allegedly because the petition fee was not paid. However, Exhibit A shows that the Petition filed October 9, 2002 contained clear instructions to charge the deposit account in the event that the Office failed to grant a withdrawal of the holding of abandonment, and instead chose to treat the petition as a Request to Revive an Unintentionally Abandoned Application. In light of the above, Applicants assert that this Petition has effectively been filed within two (2) months of the mailing of the Notice of Abandonment. Withdrawal of the holding of abandonment is respectfully requested. No fee is believed to be due for this Request.

However, if it is found that Applicants have not met the requirements set out in MPEP §711.03(c), Applicants hereby petition for revival of the above-identified application under 37 C.F.R. §1.137(b), which allows for revival of an abandoned application if the delay in responding to an Office Action is unintentional. A copy of the required reply has been filed previously, and is attached hereto as Exhibit D.¹ In such event, the Commissioner is authorized to charge \$1300.00, to cover the petition fee set forth in 37 C.F.R. §1.17(m), to Deposit Account No. 50-2387, referencing 16517.001/51469B. A duplicate copy of this petition is enclosed.

In light of the above, Applicants assert that the entire delay in filing the required reply from the due date for the reply until the filing of this petition was unintentional, and respectfully request that the application be revived.

¹ Courtesy copies of a replacement compact disk, and a Statement Regarding Sequence Submission were submitted with the Petition to Revive filed on October 9, 2002 (*See* Exhibit B), and are thus not presented herewith. A copy of the date-stamped postcard indicating receipt of the replacement compact disk, and the Statement Regarding Sequence Submission on October 9, 2002 by the United States Patent and Trademark Office is attached hereto as Exhibit C.

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe that any fees, other than those provided for in the accompanying transmittal letter, are due in conjunction with this filing. However, if any fees under 37 C.F.R. §§ 1.16 or 1.17 are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-2387, referencing matter number 16517.001/38-21(15459)C. A duplicate copy of this petition is enclosed.

Respectfully submitted,

Lawrence M. Lavin, Jr.

Lawrence M. Lavin, Jr. (Reg. No. 30,768)
by David R. Marsh (Reg. No. 41,408)

Date: May 27, 03

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